



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/891,301	07/10/1997	KENNETH HARRENTIEN	224/183	5720

23639 7590 05/31/2005
BINGHAM, MCCUTCHEN LLP
THREE EMBARCADERO CENTER
18 FLOOR
SAN FRANCISCO, CA 94111-4067

EXAMINER

TRAN, PABLO N

ART UNIT	PAPER NUMBER
----------	--------------

2685

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	08/891,301		HARRENSTIEN ET AL.	
	Examiner		Art Unit	
	Pablo N Tran		2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-100 is/are pending in the application.
- 4a) Of the above claim(s) 48 and 75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47, 49-74 and 76-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. Since the instant Application is a CIP of US Application Serial No. 08/521,660, now US patent No. 5,850,517, therefore the newly subject matters of the instant Application are entitled to the filling date of 07/10/97.

Specification

2. The amendment filed 10/15/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: "a wireless link with the server that has a higher bandwidth than the page link".

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

3. Applicant's arguments filed 10/15/04 have been fully considered but they are not persuasive.

The added limitation to claims 47 and 74 raises new matters that were not disclose in the specification, as originally filed.

Art Unit: 2685

Regarding claims 47 and 74, new subject matter, "a wireless link with the server that has a higher bandwidth than the page link", was not disclosed in the specification, as originally filed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 47 and 74 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as

Art Unit: 2685

to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 47 and 74, new subject matter, "a wireless link with the server that has a higher bandwidth than the page link", was not disclosed in the specification, as originally filed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 47, 49-55, 57-58, 60, 62-63, 65-66, 68, 70-74, 76-82, 84-85, 87, 89-90, 92-93, 95, and 97-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Eggleston et al.* (5,958,006) in view of *Krebs et al.* (5,448,759).

As per claims 47 and 74, *Anderson et al.* disclosed a method of transmitting information from a server to a client station wherein determining that the server has information to be transmitted to the client station without the client station requesting the info and transmitting a short message notification from the server to the client station via a link between the server and the client station in order to notify the client station that the server having info to be transmitted to the client station, receiving the notification message in the client station, and causing the client station to establish a wireless

Art Unit: 2685

communication link with the server in response to the received notification message (abstract).

Eggleston et al. do not disclosed such utilization of bandwidth requirement for the transmission of the message notification (short message, such as paging, required narrow bandwidth) and the message retrieval (long message required wider bandwidth). However, such utilization of bandwidth requirement is well known in the art, as taught by *Krebs et al.* (col. 2/ln. 11-40, col. 1/ln. 31-40). Therefore, it would have been obvious to one of ordinary skill in the art to provide such method of bandwidth utilization, as taught by *Krebs et al.*, to the communication system of *Eggleston et al.* to fully utilizes communication resources to transceive varying bandwidth messages effectively.

As per claims 49-50, 60, 68, 76-77, 87, and 95, the modified system of *Eggleston et al.* further disclosed connecting the client station to the transceiver to establish connection with server (see *Eggleston et al.*, fig. 1/no. 106).

As per claims 51 and 78, the modified system of *Eggleston et al.* further disclosed the client station could establish a log-on connection with the server based on the telephonic address (see *Eggleston et al.*, col. 3/ln. 35-56, col. 12/ln. 7-28, col. 13/ln. 22-55).

As per claims 52-53 and 79-80, the modified system of *Eggleston et al.* further disclosed transmitting a first request for the info, receiving the info, and transmitting further request for info (see *Eggleston et al.*, abstract, col. 2/ln. 66-col. 4/ln. 3).

As per claims 54-55, 58, 62-63, 66, 72-73, 81-82, 85, 89-90, 93, and 99-100, the modified system of *Eggleston et al.* further disclosed such paging notification message

Art Unit: 2685

requirements comprises of select type or quantity (see *Eggleston et al.*, abstract, fig. 3-4, col. 2/ln. 66-col. 4/ln. 3, see *Krebs et al.*, col. 2/ln. 11-40).

As per claims 70-71 and 97-98, the modified system of *Eggleston et al.* further disclosed transmitting the message between GSM based transceivers (see *Eggleston et al.*, col. 4/ln. 35).

The modified system of *Eggleston et al.* does not disclosed transmitting the message in an SMS paging message format. However, such is notoriously well known in the art the Examiner takes official notice of such. Therefore, it would have been obvious to one of ordinary skill in the art at the time to provide the method of SMS paging message, well known in the art, to the modified system of *Eggleston et al.* in order to save time and tariff charge.

8. Claims 56, 59, 61, 64, 67, 69, 83, 86, 88, 91, 94, and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over to modified communication system of *Eggleston et al.* in view of *Powell et al.* (WO9114332A1).

As per claims 56, 64, 83, and 91, the modified system of *Eggleston et al.* disclosed a separated transceiver but do not specifically disclose transmitting the data notification to the transceiver. However, such method is well known in the art, as taught by *Powell et al.* (pg. 7/ln. 35-pg. 8/ln. 21). Therefore, such method of providing notification (e.g., data alerts) transmitted to a separated transceiver, as taught by *Powell et al.*, to the modified communication system of *Eggleston et al.* thus allows the user to defer answering the message and the user is offered an increased level of convenience.

Art Unit: 2685

As per claims 59, 61, 67, 69, 86, 88, 94, and 96, the modified system of *Eggleston et al.* in view of *Powell et al.* further disclosed relaying the notification from the transceiver to the client station (see *Eggleston et al.*, abstract, col. 2/ln. 66-col. 4/ln. 3, see *Powell et al.*, pg. 7/ln. 35-pg. 8/ln. 21).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (571)272-7898. The examiner normal hours are 9:30 -5:00 (Monday-Friday). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (571)272-7899.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

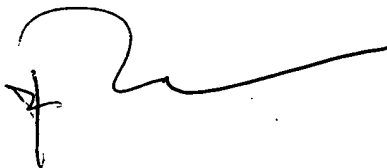
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Art Unit: 2685

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

PABLO N. TRAN
PRIMARY EXAMINER

April 2, 2005

A handwritten signature in black ink, appearing to be 'Pablo N. Tran', with a stylized, elongated horizontal stroke extending to the right.

AU2685